



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/242,540 02/18/99 BIEDERMANN

E 64978

EXAMINER

HM22/0419

FITCH EVEN TABIN & FLANNERY
135 SOUTH LASALLE STREET
SUITE 900
CHICAGO IL 60603-4277

COLEMAN, B

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

04/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/242,540

Applicant(s)

BIEDERMANN et al.

Examiner
Brenda Coleman

Group Art Unit
1624



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-41 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-41 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1624

DETAILED ACTION

Claims 1-41 are pending in the application.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8 and 14-40, drawn to compounds, compositions, process of preparing and method of use of the compounds of formula I where E is a pyrrole ring.

Group II, claim(s) 1-40, drawn to compounds, compositions, process of preparing and method of use of the compounds of formula I where E is a piperidine ring.

Group III, claim(s) 1-8 and 14-40, drawn to compounds, compositions, process of preparing and method of use of the compounds of formula I where E is a azepine ring.

Group IV, claim(s) 1-4 and 14-16, drawn to compounds, compositions, process of preparing and method of use of the compounds of formula I where E is a azocine ring.

Group V, claim(s) 1-8 and 14-40, drawn to compounds, compositions, process of preparing and method of use of the compounds of formula I where E is a oxazepine ring.

Group VI, claim(s) 1-5 and 14-16, drawn to compounds, compositions, process of preparing and method of use of the compounds of formula I where E is a oxazocine ring.

Art Unit: 1624

Group VII, claim(s) 7-8 and 14-41, drawn to compounds, compositions, process of preparing and method of use of the compounds of formula I where E is a morpholine ring.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The variable core created by the varying definition of E in formula I does not belong to a recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the other. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required.

A telephone call was made to Kenneth H. Samples on April 10, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Monday thru Friday from 9:00 AM to 5:30 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Mukund J. Shah
MUKUND J. SHAH
SUPERVISORY PATENT EXAMINER
GROUP 1600

BC
Brenda Coleman
April 10, 2000